



02 APR 2007

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In re Application of  
May :  
Application No.: 10/529,326 : DECISION  
PCT No.: PCT/EP03/10634 :  
Int. Filing Date: 24 September 2003 : ON  
Priority Date: 25 September 2002 :  
Attorney Docket No.: 119508-00282 : PETITION  
For: Torque Signal Transmission

This is in response to the renewed petition under 37 CFR 1.47(b) filed on 26 December 2006.

### DISCUSSION

In a Decision mailed on 22 June 2006, the petition under 37 CFR 1.47(b) filed on 28 October 2005 was dismissed without prejudice because

Counsel has not adequately substantiated his assertion that Mr. May has refused to sign the declaration under the standard enunciated above. The evidence of record suggests that a complete copy of the application papers may not have been provided to Mr. May, along with the oath or declaration document, prior to his alleged refusal to execute the oath or declaration. Paragraph 14 of the Declaration of Dr. Alexander Straus states in part that "Lutz May's attorney contends that not all of the file wrapper papers were provided. While this is in fact true, we did provide him with the relevant application papers, as noted above and shown in Appendix V." Petitioner has not shown exactly what "relevant application papers" were provided to Mr. May. Appendix V as provided has not been translated from German (as is true of many of the other documents accompanying the instant petition), and the record includes no statement made on the basis of first-hand knowledge to the effect that a complete copy of the application was presented to Mr. May along with an oath or declaration for his signature.

Counsel cites paragraphs 6, 7 and 13 of the Declaration of Alexander Straus to support the premise that Mr. May refused to execute the oath or declaration. Paragraph 6 states that Mr. May was contacted on 19 February 2004 "to obtain his signature on documents to be signed," and that "he refused to do so." This paragraph does not specifically identify an oath or declaration of inventorship directed to this application as among the "documents to be signed," nor does it set forth any of the details of the alleged refusal (such as specific statements Mr. May may have made). Moreover, it is not clear whether these statements are made on the basis of first-hand knowledge. In paragraph 7, counsel refers to actions allegedly undertaken by Dr. Gleichenstein (a German bankruptcy receiver or trustee) "to acquire Lutz May's signatures," and refers to (untranslated) Annex II. Again, this evidence is insufficient because it is not clear that Mr. May

specifically refused to execute an oath or declaration directed to this application, and moreover the statements available in English are not made on the basis of first-hand knowledge. Meanwhile, paragraph 13 does specifically refer to a declaration, a specification, claims, drawings, "and any amendments thereto" as having been sent to Mr. May via his attorney. Again, these statements do not specify that the papers transmitted pertain to this specific application, and they have not clearly been made on the basis of first-hand knowledge. Also, these statements are allegedly supported by further untranslated German language documentation. Moreover, as noted above, there is a question (raised by paragraph 14) as to whether the copy of the application provided to Mr. May was complete. Thus, the evidence of record does not adequately establish that Mr. May has refused to execute the oath or declaration within the meaning of 37 CFR 1.47(b).

Regarding requirement (5), ... Petitioner argues that Mr. May was an employee of bankrupt firm FAST Technology AG and argues circumstantially that FAST should be considered to have been "the owner of the above-captioned patent application and the invention disclosed therein," and cites paragraph 11 of the Straus declaration as support. However, paragraph 11 of Straus appears to be merely an assertion of "Abas, Inc.'s position," possibly based on hearsay, and not an objective evidentiary showing. Petitioner has included a copy of a transfer agreement from Dr. von Gleichenstein (trustee/receiver) to Magna-lastic Devices, Inc. of rights in certain patent applications, but the instant application does not appear to be named in said document, either by U.S. or international application number. Moreover, petitioner has not provided sufficient proof that any rights in this application were conveyed from Magna-lastic to Abas; instead, petitioner merely refers to an assertion by Steven Harders that the application was "subsequently assigned" to Abas. In the absence of a sufficient showing of the alleged proprietary interest of Abas, Inc. in this application, it would be inappropriate to conclude that requirement (5) has been satisfied.

In response, petitioner provides a copy of a Decision granting a petition under 37 CFR 1.47(b) in application no. 10/482,002, and indicates that "the material facts and evidence submitted to the PTO in connection with the '002 application are also being or have been submitted to the PTO in connection with the present Petition."

Regarding requirement (2), petitioner has provided a copy of a letter to Mr. May, dated 24 August 2005, referring to an assignment, declaration and "file portions" including the "submitted application text." However, further inspection of said letter indicates that it is directed to application no. 10/482,002. As such, it does not show that Mr. May was presented with an oath or declaration and a complete copy of the application papers for *this* case, as opposed to 10/482,002. Rather, it appears that petitioner inadvertently provided a letter directed to the other case. Therefore, requirement (2) has not been satisfied.

Regarding requirement (5), petitioner has provided a "Memorandum Of Law Prepared Pursuant To M.P.E.P. 409.03(f)" signed by Klaus Gennen, along with supporting documentation. This legal memorandum establishes sufficient proof of proprietary interest to satisfy requirement (5).

## DECISION

The petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the PCT Legal Office.



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